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27 July 1998

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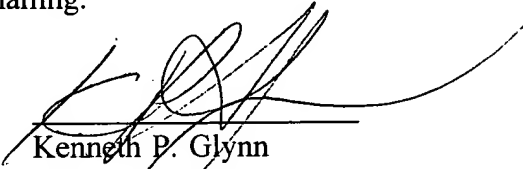
Transmitted herewith for filing is:

Inventor: Harry W. Eberle, III  
For: ANCHORING BISCUIT DEVICE FOR JOINING TWO  
ADJACENT BOARDS

Attorney Docket No. HWE-103A

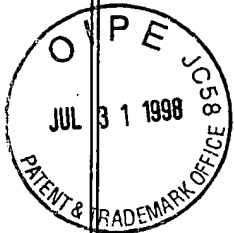
Enclosed are:

- (X) Appeal Brief (Original plus three copies);
- ( ) Check No. 7243 in the amount of \$155.00 to cover the fee for filing an Appeal Brief (was previously sent); and,
- (X) A certification of mailing.

  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#14

In re application of

HARRY W. EBERLE, III

Serial No.: 08/811,898

Filing Date: March 5, 1997

For: ANCHORING BISCUIT DEVICE  
FOR JOINING TWO  
ADJACENT BOARDS

Examiner:

HARRY C. KIM

Group Art Unit: 3509

Attorney Docket No.

HWE-103A

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APPEAL BRIEF

This brief is being filed in response to the Final  
Rejection of January 20, 1998 in the above-referenced case.

I. REAL PARTY IN INTEREST

The inventor of the instant patent application is Harry  
W. Eberle, III.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences which  
will directly affect or be directly affected by or have a  
bearing on a decision in the present Appeal Brief.

### III. STATUS OF CLAIMS

Claims 23 through 27 were submitted by amendment during prosecution and were rejected in the Final Rejection dated January 20, 1998. Claims 23 through 27 were canceled after Final Rejection and new claims 28 through 30 were submitted. However, in the Advisory Action dated March 24, 1998, the Examiner denied entry of proposed claims 28 through 30. Thus, claims 23 through 27 are pending and the subject of this Appeal.

### IV. STATUS OF AMENDMENTS

The amendment submitted on December 5, 1997 was entered with the result that claims 23 through 27 are now pending. The proposed amendment after Final Rejection submitted on March 2, 1998 was not entered.

### V. SUMMARY OF THE INVENTION

The present invention is an anchoring biscuit device for joining three boards. Appendix B contains a single page showing Figures 1 through 4. Referring specifically to Figures 1, 2 and 3 in Appendix B, there is shown a first substantially flat horizontal top element (3) having a generally biscuit-shaped top view configuration, at least two substantially vertical support members (15 and 17) attached to the underside of the top element and extending

downwardly therefrom for a predetermined length to place the top element at a predetermined height for joinder of two adjacent boards which have been pre-cut with biscuit receiving slots. (See also Figure 4 in Appendix B which illustrates the joinder arrangement.) In the present invention device there is also an attachment means established by at least one hole (13) formed at the top element and extending through or between the vertical support members for attachment of the anchoring biscuit device to a support board for anchoring and support of the two adjacent boards by screwing.

#### VI. ISSUES

The basic issues are as follows:

- (a) The appropriateness of the Examiner's rejection of claims 23 and 24 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.
- (b) The appropriateness of the Examiner's rejection of claims 23 and 24 under 35 U.S.C. §102(e) as being anticipated by Erwin et al.
- (c) The appropriateness of the Examiner's rejection of claims 23 through 27 under 35 U.S.C. §102(b) as anticipated by Ellinwood.
- (d) The appropriateness of the Examiner's rejection of claims 25 through 27 under 35 U.S.C. §103 as being unpatentable over Erwin et al in view of Bischof.

## VII. GROUPING OF CLAIMS

In this appeal, all of the claims may be grouped together.

## VIII. ARGUMENTS

**ISSUE (A):        THE APPROPRIATENESS OF THE EXAMINER'S  
REJECTION OF CLAIM 6 UNDER 35 U.S.C. §112 AS  
BEING INDEFINITE FOR FAILING TO PARTICULARLY  
POINT OUT AND DISTINCTLY CLAIM THE SUBJECT  
MATTER WHICH APPLICANTS REGARD AS THE  
INVENTION.**

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The Examiner rejected claims 23 and 24 under 35 U.S.C. §112, second paragraph, as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action, January 20, 1998. The Examiner states that claim 23, lines 13 through 16 state "attachment means established by... and there are at least two vertical support members attached to said top element" is vague and indefinite since it is unclear whether the said at least two vertical support members are the same as the said at least one vertical support member attached to the underside of the top element (lines 6 through 7), and it is unclear whether the said at least two vertical support members are part of the attachment means. In response, the Applicant concedes to

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this rejection with respect to the cited wording of claim 23. This would have been obviated if the Examiner had entered the newly submitted claims 28 through 30 after Final Rejection. Applicant would agree to overcome this rejection by appropriate amendment, if permitted by the decision granted in this appeal. However, for purposes of this appeal, please construe claim 23 to be limited to at least two vertical support members as set forth in subparagraph (c) of claim 23.

**ISSUE (B):           THE APPROPRIATENESS OF THE EXAMINER'S  
REJECTION OF CLAIMS 23 AND 24 UNDER 35 U.S.C.  
§102(e) AS BEING ANTICIPATED BY ERWIN ET AL.**

---

Claims 23 through 27 were submitted by amendment in response to the first Office Action dated November 18, 1997. The earlier pending claims had been rejected under 35 U.S.C. §102, as unpatentable over Bischof (5,529,428). Based on arguments and amendments submitted on December 5, 1997, this rejection was removed and the Examiner now states that the addition of new claims 23 through 27 submitted on December 5, 1997 necessitated new grounds for rejection and made the Office Action of January 20, 1998 a Final Rejection, even though the amendments merely narrowed the original claims! In fact, however, it is believed that the arguments

submitted on December 5, 1997 overcame the Bischof rejection and that this latest rejection should not have been made final.

Nonetheless, in the Office Action of January 20, 1998, in which the rejection was made Final, the Examiner made three new rejections, including this issue (b) art rejection with claims 23 and 24 now being rejected under 35 U.S.C. §102(e) based on Erwin et al.

Erwin et al is directed to a foam-filled extruded decking attachment system which utilized a hold down block (90, Figure 1). Erwin et al is not directed to biscuit-shaped elements, nowhere suggests or renders obvious the use of biscuit elements and, in fact, teaches away from biscuits by using a "block". Biscuits are clearly defined in the carpentry and construction art and differ from splines and blocks by their inherent arcuated shape. Erwin et al requires a block having the same type configuration as the extruded plastic planks. Because they are continuously extruded (column 3, line 55; column 4, line 17, and elsewhere), their cross-section cannot vary and cannot have biscuit cuts to receive biscuit shaped ties. The present invention is, on the other hand, used with planks having biscuit cuts, e.g. in lumber, formed by a biscuit cutter. Thus, not only does Erwin et al fail to teach biscuits, as required in a proper 35 U.S.C. §102 rejection, but Erwin et

al could not be relied upon to even suggest the obviousness of biscuit-shaped ties under 35 U.S.C. §103 because it would be contrary to the teachings and purpose of the extruded planks and matching blocks set forth therein. In fact, biscuits in Erwin et al's system would cut down on surface area contact, would be weaker and would not be obvious to one of ordinary skill in the art, or even be practical in a continuous extruded flat engaging grooves as in Erwin et al. Additionally, Erwin et al uses different physical structures in a different manner from the present invention to achieve different results. Erwin et al is neither anticipatory nor obvious over the present invention.

Hence, this rejection on Erwin et al under 35 U.S.C. §102 as stated, or even under 35 U.S.C. §103, is inappropriate and should be reversed.

**ISSUE (C):           THE APPROPRIATENESS OF THE EXAMINER'S  
REJECTION OF CLAIMS 23 THROUGH 27 UNDER 35  
U.S.C. §102(b) AS ANTICIPATED BY ELLINWOOD.**

---

Ellinwood teaches the use of T-like continuous splines for joinder of abutted panels to rafters or studs. These splines usually run the full length of the studs and even when they do not, Ellinwood states that an important feature is the dimensional relation of this connecting member to the

grooves in which it is fitted (column 1, line 46 et seq.), that the connecting member (the spline) has a shape corresponding to the grooves and space of the panels (column 1, line 49 et seq.). These grooves are continuous and flat (see e.g. the Figures of Ellinwood) and that the connecting member be snugly received by the respective groove. None of this teaches or suggests the use of biscuits or biscuit-shaped connection members, but rather, again as with Erwin et al, has specific needs and objectives which teach away from biscuit (arcuate) shapes. It is difficult to even understand the Examiner's interpretation of this reference's teachings in a manner that would render it anticipatory of the present invention. Like Erwin, it describes an invention which is structurally different, mates with a different female aspect and is used for a different purpose.

Thus, the rejection, under 35 U.S.C. §102 or even an obviousness rejection under 35 U.S.C. §103, would be inappropriate and the rejection should be reversed.

**ISSUE (D):           THE APPROPRIATENESS OF THE EXAMINER'S  
REJECTION OF CLAIMS 25 THROUGH 27 UNDER 35  
U.S.C. §103 AS BEING UNPATENTABLE OVER ERWIN  
ET AL IN VIEW OF BISCHOF.**

---

Erwin et al is discussed in detail above under Issue B, and its significant shortcomings are stated. These shortcomings stated in Issue B and all of the arguments are

incorporated herein by reference. The Bischof secondary reference does not overcome the Erwin et al deficiencies.

Bischof is directed to a metallic structural element for connecting work pieces consisting of wood, woodworking material or plastic which includes a lamellar part and a bolt-like part. The lamellar part provides a non-positive connection with a first workpiece provided with a groove and a transverse hole. The bolt-like part, through screwing or pinning, attaches the non-positive connection with the second workpiece via a longitudinal hole. In other words, the Bischof connector is a half biscuit with a planar extended screw and a traverse locking hole. Bischof does not even provide for a horizontal top element and vertical support members to create the flat top (horizontal) and the downwardly extending at right angles (vertical) support members. In fact, the Bischof device is all in a single flat plane! Thus, it is completely different from the present invention and teaches totally away from the present invention. The Examiner relies upon Bischof to reject the claims under 35 U.S.C. §103 in conjunction with Erwin et al on the basis that it would be obvious to change Erwin's device to be arcuated to reduce friction. However, this is contrary to the teachings of the main reference and is inferior and structurally different from the present invention device as claimed.

Finally, to correct a misunderstanding of Bischof,

referring to Figure 9 of Bischof, it is true that one end plate of the device shown is arc-shaped on both sides and thus biscuit-shaped. But this is merely a drilling template in Figure 9 and cannot be used as an anchoring device as in the fashion of the present invention and is still significantly structurally and functionally different. For example, stop part 25 is a solid section running the entire length of the end plate and a screw could not pass through cut-out 28 to fasten the device to anything. Stop 25 (the "vertical support member") must be solid under hole 28 to present the center mark 29. Thus, Figure 9 of Bischof shows a device which is structurally different from the present invention, serves a different purpose and achieves a different result. Even a 35 U.S.C. §103 rejection would be inappropriate because it would not be obvious to modify a cutting and drilling template into a joiner device, especially since Bischof already teaches a joiner device which is established in a single flat plane and is totally different from the present invention.

It is important to note that both the primary reference to Erwin et al and the secondary reference to Bischof show complete matching of the insertable tie and the receiving board. It is recognized throughout the art (see, e.g., Ellinwood which talks of "snug" fitting of the groove and connecting element) that boards stay fitted when connectors and receivers are male-female matching. The hindsight

argument to put a biscuit into a flat groove is nowhere taught or suggested in either reference and is not obvious.

Additionally, even the idea of combining Erwin et al's teachings with Bischof's teachings is inappropriate because Erwin et al is anchoring extruded planks with necessarily flat grooves which cannot be extruded as female biscuit (arcuate) slots, and Bischof is using a half biscuit for end-to-end wood construction. While they have the similar areas of classification, they are technically not analogous. One of ordinary skill in the art of extruded planking would not look to biscuit or half-biscuit technology for joining extruded planks because it is impossible to extrude arcuated cut-outs and surface to surface (snug) fitting is desired.

Thus, this rejection should be reversed.

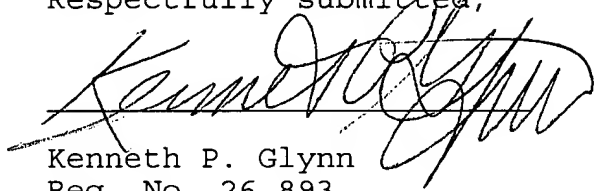
#### CONCLUSION

Applicants believe it should be clear to the Board of Appeals that currently pending claims 23 through 27 are substantively allowable over the prior art relied upon by the Examiner and that the 35 U.S.C. §112 rejection can be overcome by simple amendment. The rejections under 35 U.S.C. §102 and 35 U.S.C. §103 should be reversed. The

appealed claims are attached hereto as Exhibit A.

Thank you.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Kenneth P. Glynn", written over a horizontal line.

Date: July 27, 1998

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## APPENDIX A

23. An anchoring biscuit device for joining three boards, which comprises:

(a) a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration, said top element having an imaginary center line;

(b) at least one substantially vertical support member attached to the underside of said top element along said imaginary center line of said top element and extending downwardly therefrom for a predetermined length to place said top element at a predetermined height for joinder of two adjacent boards which have been pre-cut with biscuit receiving slots; and,

(c) attachment means established by at least one screw hole located substantially in the center of said top element and there are at least two vertical support members attached to said top element, said two vertical support members being substantially flat, being in the same plane and at least one of each vertical support members being located on opposite sides of said at least one screw hole so as to permit insertion of a screw through said top element and between said at least two vertical support members.

24. The anchoring biscuit device of Claim 23 wherein said top element and said vertical support members are uni-structurally formed.

25. An anchoring biscuit device for joining three boards, which comprises:

(a) a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration, said top element having an imaginary center line and having symmetrical, opposite sidewalls in the shape of a circular arc of predetermined radius and length and having opposite, flat endwalls;

(b) at least one substantially vertical support member attached to the underside of said top element along said imaginary center line of said top element and extending downwardly therefrom for a predetermined length to place said top element at a predetermined height for joinder of two adjacent boards which have been pre-cut with biscuit receiving slots of similar configuration to said top element sidewalls; and,

(c) attachment means established by at least one screw hole formed at said top element and extending through said vertical support member for attachment of said anchoring biscuit device to a support board for anchoring and support of said two adjacent boards by vertical screwing.

26. The anchoring biscuit device of claim 25 wherein there is at least one screw hole located substantially in the center of said top element and there are two vertical

support members attached to said top element, said two vertical support members being substantially flat, being in the same plane and one of each being located at least on opposite sides of said at least one screw hole.

27. The anchoring biscuit device of claim 25 wherein said top element and said vertical support member are uni-structurally formed.



CERTIFICATION OF MAILING

The undersigned hereby certifies that this document was delivered to the United States Post Office in Flemington, New Jersey 08822 between 7:30 a.m. and 4:45 p.m. on Monday, July 27, 1998. The undersigned further declares that this Certification is made with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under applicable sections of United States law and that willful false statements made before the United States Patent and Trademark Office may jeopardize the validity of the application or issuing patent related thereto.

  
Cheryl L. Powell

(Docket No. HWE-103A)